REMARKS

Claims 1-2, 4-19, and 21-54 are pending in the application. Claims 1, 3, 4, 19, 21, 39, 42, and 52 have been amended. The claims have been amended to clarify the scope of the invention or to correct informalities. No new matter has been introduced.

Claims 4-9, 11-12 and 21-26 stand objected to based on informalities due to improper claim dependency. Applicants have amended dependent claims 3 and 21 to depend from claims 1 and 19 respectively. Applicants respectfully request withdrawal of the objection of claims 1-2, 4-19, and 21-54.

Claims 1-2, 4-7, 10-12, 15-17, 19-22, 26-34 and 37-51 stand rejected under 35 U.S.C. §102(e) as unpatentable over U.S. Patent 6,397,197 to Gindlesperger. Applicants respectfully traverse the rejection.

Independent claim 1 relating to a computer-implemented method of obtaining a price quote recites, *inter alia*, "submitting a request for a quote by the consumer to a staging area, wherein said quote includes at least one product specification; [and] selecting, by said customer, from a carrier list, at least one carrier to provide said price quote."

Independent claim 39 relates to an electronic method for brokering a transaction and recites, *inter alia*, "receiving a selection made by said customer, from a carrier list, of at least two carriers for each of said requests for a price quote; receiving at least one price quote from a first selected carrier of said product; receiving a second quote from a selected second carrier of said product; and posting said request and said price quotes to a staging area."

Independent claim 19 relates to an "electronic method for at least two carriers, selected by a customer from a carrier list, to provide a specific quote for a product in response to a specific request for said quote from said consumer."

Independent claim 42 relates to a system for conducting an on-line auction and recites, *inter alia*, "an electronic staging area linked to said broker interface, wherein said staging area displays requests for price quotes on products submitted by consumers, forwards requests for price quotes to one or more carriers selected by said customer for each of said requests for price quotes and displays responses to said requests by said one or more carriers of said products."

Gindlesperger is directed to a method for obtaining a product bid from a plurality of carriers (i.e., vendors). In Gindlesperger, a pool of carriers, which have been previously entered by the customer, are stored by the server. The Gindlesperger system, when it receives a request for a bid, checks the carrier pool of the <u>customer</u> requesting the bid to determine whether all of the carriers provide the service requested by the customer. After the capability check is complete, the Gindlesperger system <u>automatically</u> forwards the quote to all capable carriers in the customer's carrier list. Gindlesperger does not, however, allow the customer to select the carriers to receive a price quote for <u>each</u> transaction, nor does the system provide a general carrier pool as in the present invention. The Office Action directs Applicants to column 1, lines 48-54, column 2, lines 8-11, column 3 lines 23-28, column 4, lines 4-6, column 5, lines 44-47, column 6, lines 12-16 and FIG. 3 of Gindlesperger for teaching the selection of carriers to receive a bid. However, these sections of Gindlesperger relate to the prior art of Gindlesperger in which a customer directly contacts carriers to request a quote or the invention of Gindlesperger in which the customer flags particular carriers as preferred vendors and the system may <u>automatically</u> forward quote requests to the flagged

carriers for <u>every</u> transaction. Gindlesperger does not allow, however, the customer to choose from a list of carriers provided by the staging area before <u>each</u> request for a quote is sent to the selected carriers. Accordingly, Gindlesperger fails to teach "selecting, by said customer, from a carrier list, at least one carrier to provide said price quote," as recited in claim 1, or "receiving a selection made by said customer, from a carrier list, of at least two carriers for each of said requests for a price quote" as recited in claim 39. Nor does Gindlesperger teach "[a]n electronic method for at least two carriers, selected by a customer from a carrier list, to provide a price quote for a product in response to a specific request for said quote from said consumer" as recited by claim 19. Similarly, Gindlesperger does not teach forwarding the request for price quote the carriers selected to provide each price quote as recited in independent claim 42. Thereby, Applicants respectfully request withdrawal of the rejection of independent claims 1, 19, 39 and 42 and respective dependent claims 2, 4-18, 21-38, 40-41 and 43-51.

Claims 8, 9, 18, 23-25 and 52 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,397,197 to Gindlesperger in view of U.S. Patent 5,905,975 to Ausubel. Applicants respectfully request withdrawal of the rejection.

Independent claim 52 recites, *inter alia,* "pre-registering at least one customer who is interested in obtaining a competitive price quote on a product; pre-registering at least two carriers of said product; establishing a time for said auction; having said at least one customer submit a request for a price quote and select at least two carriers from said pre-registered carriers to bid on each of said price quotes; having a first carrier submit a first price quote in response to said request; posting said first price quote for viewing by at least one of said customer and said carriers; having a second carrier submit a second price quote in response to said request and to said first price

quote; and posting said second price quote for viewing by at least one of said customer and said carriers."

As previously noted, Gindlesperger relates to forwarding quote request information to carriers and receiving price quotes from the carriers. However, Gindlesperger fails to provide an online auction as recited in independent claim 52. Further, Gindlesperger fails to disclose "establishing a time for said auction; having said at least one customer submit a request for a price quote and select at least two carriers from said pre-registered carriers to bid on each of said price quotes," as recited in independent claim 52. Ausubel relates to a computer implemented method and apparatus for auctions in which <u>sellers</u> post items for sale and at least one buyer bids on each posted item. However, Ausubel fails to teach a system in which a buyer wishes to obtain a price quote for the provision of a product. Thereby, the combination of Ausubel and Gindlesperger fails to teach or suggest the claimed invention. Furthermore, Gindlesperger teaches away from the combination of Ausubel and Gindlesperger. Specifically, column 10 of Gindlesperger notes that the invention of Gindlesperger prevents a carrier from holding back their lowest bid, however, in the invention of Ausubel the carrier may instead find it more beneficial to place a bid that is not their lowest bid so that they can bid lower than a subsequent bidder. Therefore, the carriers of Ausubel are not necessarily dissuaded from providing their lowest bid as the first bid. Therefore, there is no suggestion or motivation to combine Ausubel and Gindlesperger.

Furthermore, "[t]he mere fact that references <u>can</u> be combined or modified <u>does not</u> render the resultant combination obvious unless the prior art also <u>suggests</u> the desirability of the combination." M.P.E.P. § 2143 (emphasis added). There is no suggestion to combine the references to attain the claimed invention. Ausubel and Gindlesperger, either taken alone or in combination, fail to teach "establishing a time

for said auction; having said at least one customer submit a request for a price quote and select at least two carriers from said pre-registered carriers to bid on each of said price quotes" as recited in independent claim 52. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 52.

Claims 8, 9 and 18 depend from independent claim 1 and therefore are allowable for at least the reasons set forth above. Similarly, claims 23-25 depend from independent claim 19 and therefore are allowable for the reasons set forth above.

Claims 13-14, and 35-36 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,397,197 to Gindlesperger in view of U.S. Patent 6,282,521 to Howorka. Howorka does not over come the aforementioned deficiencies of Gindlesperger identified above. Specifically, Howorka relates to a computer trading system. Howorka does not teach "selecting, by said customer, from a carrier list, at least one carrier to provide said price quote" as recited in claim 1, or "[a]n electronic method for at least two carriers, selected by a customer from a carrier list, to provide a price quote for a product in response to a specific request for said quote from said consumer" as recited by claim 19. Accordingly, Applicants respectfully request withdrawal of the rejection.

Claims 13-14 depend from independent claim 1 and therefore are allowable for at least the reasons set forth above. Claims 35-36 depend from independent claim 19 and therefore are allowable for at least the reasons set forth above.

Claim 53 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,397,197 to Gindlesperger and U.S. Patent 5,905,975 to Ausubel, further in view of U.S. Patent 5,806,042 to Kelly. Claim 53 recites, *inter alia*, "[a]n electronic method for competitively quoting a rate of return for premiums deposited in a bank-owned life

insurance (BOLI) policy... having said financial institution submit a request for a quote during said auction."

Gindlesperger, Ausubel and Kelly, either alone or in combination, fail to teach "[a]n electronic method for competitively quoting a rate of return for premiums deposited in a bank-owned life insurance (BOLI) policy... having said financial institution submit a request for a quote during said auction." As previously noted, Gindlesperger relates to forwarding quote request information to carriers and receiving price quotes from the carriers and Ausubel relates to a computer implemented method and apparatus for auctions in which sellers post items for sale and at least one buyer bids on each posted item. Accordingly, there is not suggestion or motivation to combine a seller's auction and a price quote system taught or suggested in Gindlesperger or Ausubel. Kelly relates to a system for designing and implementing BOLI; however, Kelly does not relate to a price quote system or an electronic auction. The combination of Gindlesperger, Ausubel and Kelly would not create the claimed invention. Taken alone or in combination Gindlesperger, Ausubel and Kelly do not teach a "financial institution submit[ing] a request for a quote during said auction." Additionally, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143 (emphasis added). There is no suggestion to combine the references to attain the claimed invention. Therefore, Applicants respectfully request withdrawal of the rejection.

Claim 54 stands rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent 6,397,197 to Gindlesperger and U.S. Patent 5,806,042 to Kelly. Claim 54 recites, _inter alia_, "[a]n electronic system useful in conducting an on-line auction for rates-of-return on funds deposited in bank-owned life insurance (BOLI)."

Gindlesperger or Kelly, either alone or in combination, fail to teach "[a]n electronic system useful in conducting an on-line auction for rates-of-return on funds deposited in bank-owned life insurance (BOLI)." As previously noted, Gindlesperger relates to forwarding quote request information to carriers and fails to teach an online auction and more specifically an online auction for BOLI. Kelly does not make up the inadequacies of Gindlesperger. While Kelly relates to a system for designing and implementing BOLI, however, Kelly does not relate to a price quote system or an electronic auction. It should be noted that the present invention is not limited to BOLI, but can cover other types of products. Further, there is no suggestion or motivation to combine the references. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. § 2143 (emphasis added). There is no suggestion to combine the references to attain the claimed invention, and the mere fact that both references teach electronic systems is insufficient. Thereby, it would not have been obvious to one of ordinary skill in the art to combine a system for designing and implementing a BOLI plan with a price quote system. Furthermore, the combination of Gindlesperger and Kelly would not create the claimed invention. Accordingly, Applicants respectfully request withdrawal of the rejection.
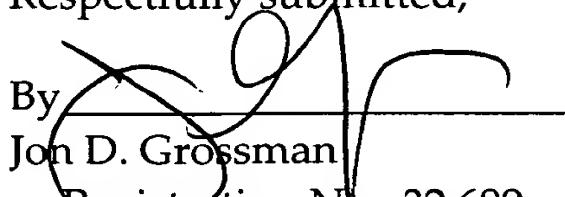
In view of the above amendments and remarks, applicant believes the

pending application is in condition for allowance.

Dated: December 20, 2005   Respectfully submitted,

By _____

John D. Grossman
  Registration No.: 32,699
DICKSTEIN SHAPIRO MORIN &
  OSHINSKY LLP
2101 L Street NW
Washington, DC 20037-1526
(202) 785-9700
Attorney for Applicant